

REMARKS

Claims 10-23 are pending in this application. By this Amendment, claims 1-9 are cancelled.

The courtesies extended to Applicants' representative by Examiner Gilman at the telephone interview held May 3, 2005, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because, e.g., they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested.

I. The Claims Define Patentable Subject Matter

A. Claims 3, 4 and 8

The Office Action rejects claims 3, 4 and 8 under 35 U.S.C. §102(b) as allegedly being anticipated by Japanese publication 2001-112148 to Hidetoshi. This rejection is moot.

By this Amendment, claims 3, 4 and 8 are cancelled. Withdrawal of this rejection is thus respectfully requested.

B. Claims 1, 2 and 6

The Office Action rejects claims 1, 2 and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hidetoshi in view of U.S. Patent No. 5,724,730 to Tanaka. This rejection is moot.

By this Amendment, claims 1 and 6 are cancelled. Withdrawal of this rejection is thus respectfully requested.

C. Claim 9

The Office Action rejects claims 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hidetoshi in view of Tanaka and further in view of U.S. Patent No. 5,287,894 to Shukushima et al. This rejection is moot.

By this Amendment, claim 9 is cancelled. Withdrawal of this rejection is thus respectfully requested.

D. Claims 10, 11, 13, 14, 18, 19, 21 and 23

The Office Action rejects claims 10, 11, 13, 14, 18, 19, 21 and 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicants' admitted prior art (Figs. 7 and 8 (hereinafter "APA")) in view of U.S. Patent No. 6,390,854 to Yamamoto et al. This rejection is respectfully traversed.

As similarly argued in the April 11, 2005 Request for Reconsideration, Applicants respectfully assert that Figs. 7 and 8 do not qualify as APA. As supported by the specification, Figs. 7 and 8 are only recited as "Related Art." See, e.g., page 1. Nowhere does the specification admit that Figs. 7 and 8 are prior art made by another. As the specification clearly supports the assertions that Figs. 7 and 8 are only Related Art, Figs. 7 and 8 do not qualify as APA and the rejection must be withdrawn.

Further, as discussed during the telephone interview, Yamamoto does not qualify as prior art under any section of 35 U.S.C. §102, because Applicant's priority date precedes the effective filing date of Yamamoto. The U.S. filing date of Yamamoto is July 13, 2001, and it was patented in the United States on May 21, 2002. Yamamoto claims priority from JP Application No. 2000-213086, filed on July 13, 2000. JP Application No. 2000-213086

corresponds to JP Pub. No. 2002-033438, which was published on January 31, 2002. A copy of the English Abstract for Application No. 2000-213086 is attached.

However, the present application has a U.S. filing date of June 25, 2003, which is a continuation application of U.S. Patent No. 6,740,814, filed on June 10, 2002. The parent application claims priority from JP 2001-178433 filed June 13, 2001. The priority was claimed in the parent by a certified copy on July 8, 2002, and was acknowledged by the USPTO. An accurate English-language translation was filed with the Request for Reconsideration After Final Rejection and fully supports the instant claims.

Yamamoto is not prior art to the instant application because: 1) the effective filing date of Yamamoto, July 13, 2001, is after the priority date of the above-identified application, June 13, 2001; 2) the rejection relies on the U.S. application of Yamamoto and must rely on the U.S. filing date (not the filing date of JP Application No. 2000-213086); and 3) even if the rejection relies on JP 2001-213086, the rejection must rely on the publication date, January 31, 2002, which is after the priority date of the above-identified application, June 13, 2001. Because Yamamoto is not prior art to the instant application, the rejection must be withdrawn.

Thus, because Figs. 7 and 8 do not qualify as APA and Yamamoto does not qualify as prior art under 35 U.S.C. §102, the rejection under 35 U.S.C. §103(a) should be withdrawn. Withdrawal of this rejection and prompt allowance are respectfully requested.

E. Claims 12 and 15

The Office Action rejects claims 12 and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over the APA in view of Yamamoto and further in view of Shukushima. This rejection is respectfully traversed.

Shukushima is cited in the Office Action merely for allegedly disclosing a heat resisting tube to protect the harness during over molding. Thus, Applicants respectfully

submit that Yamamoto and Shukushima do not remedy the deficiencies of APA with respect to claim 10.

Claims 12 and 15 depends from claim 10. Thus, for at least the reasons discussed above with respect to claim 10, as well as the additional features it recites, claims 12 and 15 would not have been rendered obvious by APA in view of Yamamoto and further in view of Shukushima. Withdrawal of this rejection and prompt allowance are respectfully requested.

F. Claim 5

The Office Action rejects claim 5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hidetoshi in view of Tanaka and further in view of this U.S. Patent No. 6,155,871 to Machado. This rejection is moot.

By this Amendment, claim 5 is cancelled. Withdrawal of this rejection is thus respectfully requested.

G. Claim 7

The Office Action rejects claims 7 under 35 U.S.C. §103(a) as allegedly being patentable over Hidetoshi in view of Machado. This rejection is moot.

By this Amendment, claim 7 is cancelled. Withdrawal of this rejection is thus respectfully requested.

H. Claims 20 and 22

The Office Action rejects claims 20 and 22 under 35 U.S.C. §103(a) as allegedly being unpatentable over APA in view of Yamamoto and further in view of Machado.¹ This rejection is respectfully traversed.

Applicants submit that Machado and Yamamoto do not remedy the deficiency of the APA with respect claim 13. Claims 20 and 22 depend from claim 13. Thus, for at least the

¹ The Office Action indicates claims 22 and 22 are rejected. Applicants contacted Examiner Gilman who indicated that claims 20 and 22 are rejected.

reasons discussed above with respect to claim 13, as well as the additional features it recites, claims 20 and 22 would not have been rendered obvious by APA in view of Yamamoto and Machado. Withdrawal of the rejection and prompt allowance are respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 10-23 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:RBI/cfr

Attachments:

Petition for Extension of Time
English Abstract for JP Appln. No. 2000-213086

Date: May 12, 2005

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<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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PATENT ABSTRACTS OF JAPAN

(11)Publication number : 2002-033438

(43) Date of publication of application : 31.01.2002

(51)Int.Cl. H01L 25/04
H01L 25/18
H01L 23/28
H01R 43/24

(21)Application number : 2000-213086 (71)Applicant : DENSO CORP

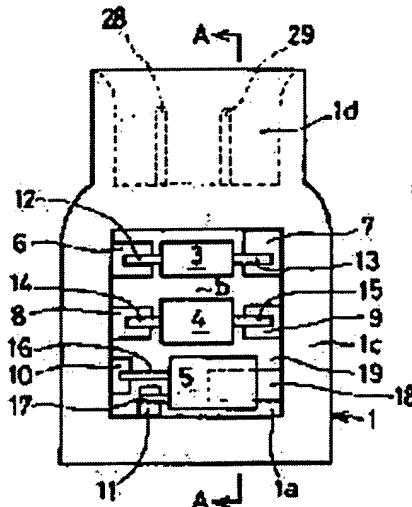
(22)Date of filing : 13.07.2000 (72)Inventor : YAMAMOTO NAOKI
IRIE HITOSHI

(54) RESIN-SEALED CIRCUIT DEVICE

(57) Abstract:

PROBLEM TO BE SOLVED: To provide a resin-sealed large circuit device which is compact, superior in reliability, and simple in manufacturing process and allows used materials to be reduced.

SOLUTION: A resin circuit case 1 having recesses 1a for holding circuit elements holds circuit elements 3-5 having lead terminals 12-17 in the recesses 1a, the case 1 has wiring metal pieces 6-11 projecting into the recesses 1a, and the metal pieces 6-11 mount the lead terminals 12-17 and are soldered. A sealing resin 19 is filled in the recesses 1a.



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[Date of request for examination]

[Date of sending the examiner's decision of rejection]

[Kind of final disposal of application other than the examiner's decision of rejection or